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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,079	07/16/2003	Kenneth L. Levy	P0856	1849
23735 7590 08/18/2009 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008				
EXAMINER WILLIAMS, JEFFERY L.				
ART UNIT 2437		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/622,079

**Applicant(s)**

LEVY ET AL.

**Examiner**

JEFFERY WILLIAMS

**Art Unit**

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30, 36 - 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30, 36 - 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

This action is in response to the communication filed on 5/12/09.

All objections and rejections not set forth below have been withdrawn.

Claims 30, 36 – 55 are pending.

In view of the appeal brief filed on 5/12/09, PROSECUTION IS HEREBY  
REOPENED. Additional rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the  
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply  
under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed  
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and  
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth  
in 37 CFR 41.20 have been increased since they were previously paid, then appellant  
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by  
signing below.

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2436

**Drawings**

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the added features of *"monitoring or analyzing a content item", "a list of content items... comprising a subset of content items designated as active", "the list of content items being respectively associated with one or more fingerprints derived from the content items themselves", "deriving at least one fingerprint", "each item on the list of content items being respectively associated with one or more fingerprints derived from the respective content item itself", "receiving a playlist, the playlist identifying ...", "based at least in part on the playlist", "updating the list of content items by adding at least a plurality of content items and removing at least a plurality of content items, but not all of the content items from the list"; "deriving at least one fingerprint from a content item monitored or analyzed from the network"; "interrogating the list of content items with at least one derived fingerprint", "receiving a list of content items, with each item on the list of content items being associated with one or more fingerprints derived from the respective content item itself", "adding and deleting entries in a table or data structure according to the list of content items"; "identifying a subset of the limited list of content items as active content items, the subset being associated with those content items being subject to updates"; "deriving at least one fingerprint from a content item monitored or obtained", "identify the monitored or obtained content item", "said act of deriving comprises deriving two or more fingerprints of the content item", and "said act*

1 *of interrogating the list of content items utilizes the two or more fingerprints*" must be  
2 shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3         Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in  
4 reply to the Office action to avoid abandonment of the application. Any amended  
5 replacement drawing sheet should include all of the figures appearing on the immediate  
6 prior version of the sheet, even if only one figure is being amended. The figure or figure  
7 number of an amended drawing should not be labeled as "amended." If a drawing figure  
8 is to be canceled, the appropriate figure must be removed from the replacement sheet,  
9 and where necessary, the remaining figures must be renumbered and appropriate  
10 changes made to the brief description of the several views of the drawings for  
11 consistency. Additional replacement sheets may be necessary to show the renumbering  
12 of the remaining figures. Each drawing sheet submitted after the filing date of an  
13 application must be labeled in the top margin as either "Replacement Sheet" or "New  
14 Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,  
15 the applicant will be notified and informed of any required corrective action in the next  
16 Office action. The objection to the drawings will not be held in abeyance.

**Specification**

The abstract of the disclosure is objected to because the amendment of 5/1/08 introduces new matter. See Objection to the Specification below. Correction is required. See MPEP § 608.01(b).

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide proper antecedent basis for the recitations of "monitoring or analyzing a content item", "a list of content items... comprising a subset of content items designated as active", "the list of content items being respectively associated with one or more fingerprints derived from the content items themselves", "deriving at least one fingerprint", "each item on the list of content items being respectively associated with one or more fingerprints derived from the respective content item itself", "receiving a playlist, the playlist identifying ...", "based at least in part on the playlist", "updating the list of content items by adding at least a plurality of content items and removing at least a plurality of content items, but not all of the content items from the list"; "deriving at least one fingerprint from a content item monitored or analyzed from the network"; "interrogating the list of content items with at least one

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1 *derived fingerprint*", "receiving a list of content items, with each item on the list of  
2 *content items being associated with one or more fingerprints derived from the*  
3 *respective content item itself*", "adding and deleting entries in a table or data structure  
4 *according to the list of content items*"; "identifying a subset of the limited list of content  
5 *items as active content items, the subset being associated with those content items*  
6 *being subject to updates*"; "deriving at least one fingerprint from a content item  
7 *monitored or obtained*", "identify the monitored or obtained content item", "said act of  
8 *deriving comprises deriving two or more fingerprints of the content item*", and "said act  
9 *of interrogating the list of content items utilizes the two or more fingerprints*".

#### ***Claim Rejections - 35 USC § 112***

##### **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

14 The specification shall contain a written description of the invention, and of the manner and process of  
15 making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the  
16 art to which it pertains, or with which it is most nearly connected, to make and use the same and shall  
17 set forth the best mode contemplated by the inventor of carrying out his invention.

18 **Claims 30, 36 – 55 are rejected under 35 U.S.C. 112, first paragraph, as**  
19  
20 **failing to comply with the written description requirement.** The claim(s) contains  
21 subject matter which was not described in the specification in such a way as to  
22 reasonably convey to one skilled in the relevant art that the inventor(s), at the time the  
23 application was filed, had possession of the claimed invention. Applicant has not  
24 pointed out where the new (or amended) claim is supported, nor does there appear to

be a written description of the claim limitations in the application as filed (see above objection to the specification).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30, 40 – 45, and 52 – 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, these claims comprise recitations of “active”, such as within the phrases “content items designated as active” [claim 30] and “content items as active content items” [claim 40]. The examiner notes that a standard meaning for “active” when used to describe content items does not exist amongst those of ordinary skill in the art. It is noted that an applicant can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. In the instant case, however, the applicant fails to provide a definition for “active” as would be applied to content items as well as the applicant fails to clearly set forth within the applicant's specification the meaning of “active” as would be applied to content items. Thus, the scope of 30, 40 – 45, and 52 – 55 is rendered unclear. For the purpose of examination, the examiner presumes the reference to the term “active”, nominally describing a content item, to mean the intention of some sort of activity, operation, capability, or expression to be associated with the content item.



***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 30, and 36 – 55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Specifically regarding claims 30, 36, 38, and 40 – 55, they are rejected as they comprise a method which fails to (1) be tied to a particular machine or apparatus or transforms or (2) transform a particular article to a different state or thing.

Specifically regarding claims 37 and 39, they fail to demonstrate a machine imposing meaningful limits on the scope of claims 1 – 15. Essentially, these claims comprise merely field-of-use limitations wherein the method of claims 1 – 15 is tied to instructions. Such limitations are insufficient to render an otherwise ineligible method claim patent-eligible.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious*

1           *at the time the invention was made to a person having ordinary skill in the art to which said*  
2           *subject matter pertains. Patentability shall not be negated by the manner in which the invention*  
3           *was made.*

4  
5  
6           **Claims 30 and 36 – 55 are rejected under 35 U.S.C. 103(a) as being**  
7           **unpatentable over Schmelzer, “Copyright Detection and Protection System and**  
8           **Method”, U.S. Patent Publication 2003/0037010 in view of Razdan, “Real-time,**  
9           **Distributed, Transactional, Hybrid Watermarking Method to Provide Trace-ability**  
10          **and Copyright Protection of Digital Content in Peer-to-Peer Networks”, U.S.**  
11          **Patent Publication 2002/0168082.**

12  
13          Regarding claim 30, Schmelzer discloses:

14          *maintaining a limited list of content items, the list comprising a subset of content*  
15          *items designated as active, the list of content items being respectively associated with*  
16          *one or more fingerprints derived from the content items themselves (par. 6, 7, 34 –*  
17          *herein it is shown that the list comprises registered and monitored (i.e. “active”)*  
18          *copyrighted works, a subset of all copyrighted works);*

19          *deriving at least one fingerprint from a content item monitored or analyzed from*  
20          *the network; and interrogating the limited list of content items with at least one*  
21          *fingerprint to identify the monitored content item (par. 34)*

22          Schmelzer does not appear to explicitly disclose that a network within a content  
23          fingerprinting system may comprise broadcast network. Razdan discloses that

1 fingerprinting systems may comprise broadcast networks that broadcast content (par.  
2 32, 37, 38). It would have been obvious to recognize the broadcasting features as  
3 found within prior art fingerprinting systems such as Razdan within the fingerprinting  
4 system of Schmelzer. This would have been obvious because one of ordinary skill in  
5 the art would have been motivated by the advantages of a more flexible and socially  
6 relevant system.

7  
8       Regarding claims 36 – 55, they are rejected, at least for the same reasons as  
9 claim 30, and furthermore because the prior art combination enables the features of  
10 *receiving a list of content items...storing the list of content items in a table or data*  
11 *structure; receiving a content item, the content item comprising audio or video; deriving*  
12 *a fingerprint from the content item itself...communicating a signal representing at least*  
13 *the identified content item to a remote device* (Schmelzer, par. 33, 34, 79; fig. 1:121,  
14 123; par. 47), “*updating the list of content items by adding at least a plurality of content*  
15 *items and removing at least a plurality of content items, but not all of the content items*  
16 *from the list*” and “*adding and deleting entries in a table or data structure according to*  
17 *the list of content items*” (Schmelzer, par. 67, 83 – herein content items are enabled to  
18 be updated - it is noted that it was well known by those of ordinary skill in the art that  
19 updating may comprise removing information) “*deriving at least one fingerprint from a*  
20 *content item monitored or analyzed from the network*”; “*receiving a list of content items,*  
21 *with each item on the list of content items being associated with one or more*  
22 *fingerprints derived from the respective content item itself*”, “*interrogating the list of*

1 *content items with at least one derived fingerprint*", "said act of deriving comprises  
2 *deriving two or more fingerprints of the content item*", "said act of interrogating the list of  
3 *content items utilizes the two or more fingerprints*" (fig. 2, 4, 6 - herein a plurality of  
4 identifiers ("fingerprints") are derived and used for identifying listed content items).

5  
6  
7 ***Response to Arguments***

8  
9 Applicant's arguments with respect to the pending claims have been considered  
10 but are moot in view of the new ground(s) of rejection.

11  
12 Applicant's arguments filed 5/12/09 have been fully considered but they are not  
13 persuasive.

14  
15 *Applicant argues or asserts essentially that:*

16 First, the final Office Action's characterization overstates Schmelzer's teachings  
17 and the reasonable inferences that should be drawn there from. For example,  
18 Schmelzer does not designate a subset of the content items represented on the list of  
19 content item as "active".

20 Second, the final Office Action's characterization misinterprets claim 30. Claim 30  
21 requires that a subset of the maintained list of content items be designated as "active".  
22 The final Office Action, instead, would say that the entire maintained list include a

"subset" of all possible copyright works. See the final Office Action, page 7, lines 1-3.  
Indeed, Schmelzer does not designate a subset of the maintained list of content items  
as "active," as required by claim 30. (Brief, pg. 7)

*Examiner respectfully responds:*

First, the examiner respectfully notes that claim 30 is a method claim comprising  
the step of "maintaining a list of content items". The examiner points out that  
designating "*a subset of the content items represented on the list of content item as  
"active"*" is not a method step. Thus, applicant's assertion that the prior art *does not  
designate a subset of the content items represented on the list of content item as  
"active"* is irrelevant. In response to applicant's argument that the references fail to  
show certain features of applicant's invention, it is noted that the features upon which  
applicant relies (i.e., *designate a subset of the content items represented on the list of  
content item as "active"*) are not recited in the rejected claim(s). Although the claims  
are interpreted in light of the specification, limitations from the specification are not read  
into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.  
1993).

Furthermore, the examiner respectfully notes that the mere description of content  
as "active" (i.e. the applicant is calling content items on a list by the name "active") fails  
to impart any functional limitation to the claimed method. Thus, the examiner finds the  
applicant's assertions unpersuasive.

Second, the examiner respectfully notes that the claims do not recite designating "a subset of the maintained list of content items as "active". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., designate a subset of the maintained list of content items as "active,") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner points out that the claim recites maintaining a list of content items. As noted within the rejection, the prior art discloses maintaining such a list of registered content items, wherein it is explicitly shown within the prior art that the registered content items comprising the list are a subset of existing copyrighted content (Schmelzer, par. 6, 7, 34).

*Applicant argues or asserts essentially that:*

Claim 40 recites - in combination with other features - identifying a subset of a list of content items as active content items, the subset being associated with those content items being subject to updates.

... Indeed, there is no analysis supporting the rejection of claim 40, including the features of a "subset being associated with those content items being subject to updates". (Brief, pg. 8 – see also applicant's similar assertion on pg. 9 )

*Examiner respectfully responds:*

The rejection explicitly shows that the list of content items is updated (e.g. see Final Rejection, 7/24/08, pg. 7, 8). Thus, the examiner respectfully notes that applicant's allegation that the rejection fails to support the rejection of the language (i.e. the subset being associated with those content items being subject to updates) clearly appears unpersuasive.

Furthermore, the examiner respectfully notes that the applicant's nominal description of content as "subject to updates" fails to impart any functional limitation to the claimed method. Thus, the examiner finds the applicant's assertions that the prior art fails to meet the claimed limitations to be unpersuasive.

*Applicant argues or asserts essentially that:*

Indeed, the above passages say nothing of updating the list of content items based at least in part on a received playlist (which playlist indicates content items to be transmitted through the network during a predetermined time period).

Second, the cited passages (paragraphs 67 and 83) say nothing of updating the list of content items by adding at least a plurality of content items and removing at least a plurality of content items. At best, the passages talk about receiving and storing fingerprint identifiers (see paragraph 83). These passages say nothing of adding a plurality of content items and removing a plurality of content items. Here, again, the final

Office Action overstates the teaching of Schmelzer. (Brief, pg. 11, see also similar argument on pg. 12).

*Examiner respectfully responds:*

The examiner respectfully notes that the rejection explicitly directs the applicant to relevant portions of the prior art wherein it is clearly seen that content providers submit a plurality or "lists" of copyrighted content items to be registered or maintained with the content protection system (e.g. see Schmelzer, par. 6, 7, 34, 78, 79). Additionally, the rejection furthermore details the fact that the prior art discloses the updating of the content protections system's database or "list" of content items by virtue of received plurality of content items from the content providers (e.g. see Schmelzer, par. 34, 67, 79, 83). Thus, the examiner notes that the rejection clearly shows that the prior art enables updating a list of content items by adding at least a plurality of content items, wherein the updating is based at least in part on a received playlist (which playlist indicates content items to be transmitted through the network during a predetermined time period). Additionally, the examiner notes that the applicant's intended use recitation (i.e. essentially - *which playlist indicates content items to be transmitted through the network during a predetermined time period*) fails to further add limiting method steps and therefore is irrelevant to the claimed method.

Furthermore, regarding the recitation that the updating of the list comprises "removing at least a plurality of content items" from the list, the examiner notes that the rejection clearly stated "*it was well known by those of ordinary skill in the art that*



1 *updating may comprise removing information*" (e.g. see Final Rejection, 7/24/08, pg. 8).  
2 Thus, the rejection clearly showed that the prior art enables "removing at least a  
3 plurality of content items".

4 However, the applicant fails to adequately traverse the finding that "*it was well*  
5 *known by those of ordinary skill in the art that updating may comprise removing*  
6 *information*". Namely, the applicant fails to specifically point out the supposed errors in  
7 the examiner's action, including stating why the noticed fact is not considered to be  
8 common knowledge or well-known in the art. See 37 CFR 1.111(b). See also  
9 Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by  
10 appellant for the examiner to produce authority for his statement, we will not consider  
11 this contention.").

12 Thus, the examiner notes for the record that should clearly indicate in the next  
13 Office action that the fact that "*it was well known by those of ordinary skill in the art that*  
14 *updating may comprise removing information*" is taken to be admitted prior art because  
15 applicant fails to adequately traverse the examiner's assertion.

16  
17 *Applicant argues or asserts essentially that:*

18 We respectfully submit that the claims have adequate written description support.  
19 Indeed, support for the claims can be found throughout the application including, e.g.,  
20 page 10, line 1 - page 12, line 7; Fig. 1; and Fig. 2. These sections and figures describe  
21 methods and. (Brief, pg. 13).

22

*Examiner respectfully responds:*

The examiner respectfully notes that the applicant's arguments comprise only an allegation that the added claim recitations are supported within the applicant's original disclosure. The applicant fails to specifically point out such support for the claim amendments as required. For this reason at least, the examiner notes that the applicant's arguments are unpersuasive.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

### **See Notice of References Cited.**

A shortened statutory period for reply is set to expire 3 months (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery Williams whose telephone number is (571) 272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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1 Information regarding the status of an application may be obtained from the  
2 Patent Application Information Retrieval (PAIR) system. Status information for  
3 published applications may be obtained from either Private PAIR or Public PAIR.  
4 Status information for unpublished applications is available through Private PAIR only.  
5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
6 you have questions on access to the Private PAIR system, contact the Electronic  
7 Business Center (EBC) at 866-217-9197 (toll-free).

8 /Nasser G Moazzami/  
Supervisory Patent Examiner, Art Unit 2436

9  
10 J. Williams  
11 AU 2137  
12